

HEIDL RIEDEL ET AL.
USSN 10/016,964
REPLY TO OFFICE ACTION DATED NOVEMBER 4, 2003
AMENDMENT DATED NOVEMBER 4, 2004

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 14 was rejected under 35 USC § 102(b) as being anticipated by Bellon et al. ("Bellon"), FR 2,789,397. In response, Applicants have canceled claim 14, but reserve the right to prosecute it in a divisional application should Applicants later desire.

Claims 1-6, 11, 13 and 15 were rejected under 35 USC § 103(a) as being obvious over

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Bellon.

Claims 8-10 were rejected under 35 USC §103(a) as being obvious over Bellon in view of Synder, US 4,708,813.

Claim 12 was rejected under 35 USC § 103(a) as being obvious over Bellon in view of Saint-Leger et al. ("Saint-Leger"), US 5,939,077.

In response to all three obviousness rejections, Applicants submit that the difference between the instant claims is not obvious. Although the Examiner's continued reliance on *In re Aller*, 105 USPQ 233 (CCPA 1955) is noted, that case pertained to *process* claims, which are not here involved, and, moreover, addressed the optimization of known result-effective variables. See, e.g., *In re Antoine*, 195 USPQ 6 (CCPA 1977), for the proposition does not apply where the prior art does not reveal the optimized variable to be result-effective. The prior art does not reveal the choice and quantity of emulsifiers to be a result-effective variable effecting long-term stability of the preparation. Indeed, as previously noted, Bellon says very little about the importance of the emulsifier. Therefore, Applicants again submit that, as a matter of law, Bellon cannot render the present claims *prima facie* obvious.

Further on this point, Applicants note that the specification teaches at page 2, lines 15-23,

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that the known foams have only low stability, wherein they usually collapse within approximately 24 hours. Cosmetic compositions, however, should be stable for as long as possible, preferably years. The prior art has solved this problem by, for example, by preparing the foam at the time the consumer intends to use it by providing packages that mix the base and a propellant at the time of use, thereby producing the foam.

As taught in the specification at page 2, lines 30 ff, the prior art does not include any sort of cosmetic or dermatological preparations that are foamed when first prepared, yet which can be packaged, stored and marketed. It is further taught in the very next paragraph, which appears at the top of page 3, that the present invention had the object of providing preparations that do not suffer these disadvantages. It is further thought on page 4, lines 12-18, that the inventive preparations are extraordinarily stable, even in cases of an unusually high gas volume.

Bellon does not teach or suggest anywhere that emulsifier choice and quantity are result-effective variables affecting long-term stability of the type involved here. In fact, as noted above, Bellon teaches little, if anything, about the importance of the emulsifier in any respect. Consequently, a person having ordinary skill in the art would not, in fact, have been motivated to optimize the emulsifier amounts required according to the present claims. Therefore, Bellon does not make out a *prima facie* case of obviousness.

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New claim 16 requires that the foam be packaged, which, as discussed above, finds support in the specification as filed. Bellon's mousse is intended to be formed by the consumer at the time of use. Therefore, Bellon does not teach or suggest the prepackaged foams as required by new claim 16.

The secondary references are of no help in bridging the gap between Bellon and the instant claims. Synder is relied upon only to teach the additional features of dependent claims 8-10, and Saint-Leger is relied upon only to teach the use of carbon dioxide as an expansion gas. Consequently, the combination of Bellon and these secondary references still fails to render obvious the basic features of the present invention.

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw all of the prior art rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

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telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By

Kurt G. Briscoe
Reg. No. 33,441

875 Third Avenue
18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 and the accompanying Request for Continued Examination and Petition for Extension of Time (12 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 4, 2004

By:

Kurt G. Briscoe